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OFFICE OF PETITIONS

In re Application of
Kemp II
Application No. 09/590,692
Filed: June 9, 2000
Attorney Docket No. 024051-0135

DECISION GRANTING REQUEST FOR
PTA RECONSIDERATION

This decision is in response to applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 145(b)" timely¹ file on March 5, 2004 request that the Office deem the proper PTA amount at the time of the mailing of the notice of allowance as 443 days rather than the zero (0) day determination provided by the office.

The applicants' request for reconsideration of patent term adjustment is **Granted to the extent herein indicated**. Applicants are entitled to **TWO HUNDRED AND NINETEEN (219) DAYS** of PTA at the time of the mailing of the notice of allowance. Applicants are given thirty days to petition this decision. The thirty day period is not extendable under 37 CFR 1.136.

Applicants assert that the Office erred in incorrectly asserting a forty-six (46) day reduction for the late submission of a response to the Notice to File Missing Parts² under 37 CFR 1.704(b) and the one hundred and fifty-four day delay for the submission of a supplemental paper (i.e., IDS filed on March 12, 2002.. Applicants assert that they did not fail to engage in reasonable efforts to conclude process of the application.

A review of the file reveals that the Office failed to meet the requirement of responding to the Request for Continued Examination (RCE) filed November 12, 2003 (RCE), until February 10, 2004, a 335 day delay.² In addition, the Office further did not meet the requirement of the application under 1.702(a)(2) by filing a late reply to applicants response rejection, a one

¹Issue fee paid on 3-8-04.

²Pursuant to 37 CFR 11.704(b), the reduction began the day after four-months from the receipt of the and ended on the date of the mailing of the Notice of Allowance on February 10, 2004. The Office notes for the record that the entry of an RCE on March 19, 2003 was an error in that the document was only a copy of the RCE filed on November 12, 2002.

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hundred and seventy-two (172) day delay.³ Accordingly, the Office accumulated a total of five hundred and seven (507) days of administrative delay.

The Office further agrees with applicant that the forty-six (46) day reduction for the response to the missing parts is in error. The file record reflects that the Office did in fact receive applicants' response to the Notice to File Missing Parts within three months. However, applicants assertion that the one hundred and fifty-four day reduction is not a failure to engage in reasonable efforts to conclude prosecution of the application is not persuasive. Applicant submitted an supplemental paper, Information Disclosure Statement (IDS)⁴, on March 12, 2002 after the initial response by applicant and prior to an Office response, a one hundred and fifty-four (154) day reduction.⁵ Moreover, applicant submitted a second supplemental reply (IDS) on February 11, 2003 after the initial filing of a RCE in response to an Office act on November 12, 2002 and prior to any response by the Office, a ninety-one (91) day reduction.⁶ In addition, The Office properly assessed a thirty-one (31) day reduction for an overdue reply to a non-final rejection dated June 8, 2001.⁷ Finally, applicants filed an over three month response to the Office Mailing of a Notice of Allowance, a twelve (12) day reduction. Accordingly, applicants failed to engage in reasonable efforts to conclude prosecution of the application by a total period of two hundred and eighty eight (288) days. Accordingly the overall PTA determination at the time of the issuance of the patent is two hundred and nineteen days.

The Office has charged the \$200 fee to Deposit Account 19-0741. No additional fee is required by applicants.

This Application will be forwarded to the Office of Patent Publication for a prompt issuance of the application.

Key File for
Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Attachment: Copy of adjusted PTA determination

³The Office did not reply to applicant's response on October 9, 2001 until July 31, 2002.

⁴IDS was filed without a one-month certification statement under 37 CFR 1.704(d) and therefore the reduction is considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704(c)(8).

⁵The reduction is for the time period between the dates of October 9, 2001 and March 12, 2002.

⁶ IDS was filed without a one-month certification statement under 37 CFR 1.704(d) and therefore the reduction is considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704(c)(8). The reduction occurring between the dates of November 13, 2002 and February 11, 2003.

⁷The reduction occurring beginning on August 9, 2001 and ending on October 9, 2002, a thirty-one day reduction.